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DEC 15 2009

In re Patent No. 7,520,881	:	OFFICE OF PETITIONS
Issued: April 21, 2009	:	
Application No. 10/719,764	:	PATENT TERM ADJUSTMENT
Filed: November 21, 2003	:	
Dkt. No.: 10000/209	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)," filed June 16, 2009.

The application for patent term adjustment (PTA) under 37 CFR 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,520,881 on April 21, 2009. The patent issued with a patent term adjustment of 471 days. The instant application for patent term adjustment was timely filed in accordance with 37 CFR 1.705(d). Patentees argue that the application is entitled to an additional adjustment of 74 days in accordance with 37 CFR 1.703(a)(3) in connection with the mailing of a non-final Office action on April 30, 2008. Patentees also argue that the application is entitled to an additional adjustment of 329 days pursuant to 37 CFR 1.703(b) on the basis that the Office took in excess of three years to issue the above-referenced patent. Patentees reference Wyeth v. Dudas, Civil Action No. 07-1492, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. Sept. 30, 2008) and assert that the patent is entitled to an adjustment of 874 days (675 days pursuant to 35 USC 154(b)(1)(A) *plus* 329 days pursuant to 35 USC 154(b)(1)(B) *less* 130 days of applicant delay).

As to patentees' contention that the patent is entitled to an additional adjustment of 74 days in accordance with 37 CFR 1.703(a)(3) in connection with the mailing of the non-final Office action on April 30, 2008, patentees are advised that any request for reconsideration under 37 CFR 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under 37 CFR 1.705(b) shall be dismissed as untimely as to those issues. As the 74 day adjustment that patentees assert that the patent is entitled, patentees' request for reconsideration of said adjustment is dismissed as untimely.

As to patentees' argument that the patent is entitled to an additional adjustment of 329 days pursuant to 37 CFR 1.703(b), patentees are advised that under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the filing of the request for continued examination (RCE) on October 16, 2007, the application was pending three years and 328 days after its filing date (November 22, 2006 to October 15, 2007). The Office asserts that at the time of filing of the RCE certain action was not taken within the specified time frame, and thus, the entry of a period of adjustment of 509 days is

correct. At issue is whether patentees should accrue 328 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 509 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 328 days of delay in issuing the patent overlaps with the 509 days of examination delay under 37 CFR 1.702(a). Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)¹ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning

¹ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), November 21, 2003, and ending on October 15, 2007, the day before the date that the RCE was filed on October 16, 2007.

Prior to the filing of the RCE, pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), the application was accorded 509 days of examination due to examination delay. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), the application was pending three years and 328 days prior to the filing of the RCE.

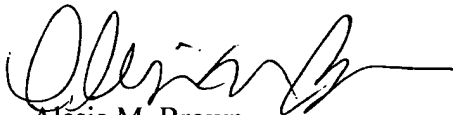
The 328 days of delay in issuance of the patent under 37 CFR 1.702(b) overlap with the 509 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 328 days and the 509 days is neither permitted nor warranted given that 509 days is the actual number of days issuance of the patent was delayed as of the filing of the RCE.

Accordingly, at issuance, having considered the 328 days of Office delay under the three-year pendency provision in conjunction with the 509 days of examination delay under 37 CFR 1.702(a)(1) that accrued prior to the filing of the RCE and the 92 days of examination delay under 37 CFR 1.702(a)(2) that accrued subsequent to the filing of the RCE, reduced 130 days for applicant delay, the Office properly entered 471 days of patent term adjustment.

In view thereof, no adjustment to the patent term will be made.

No additional fees are due in connection with this matter.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.



Alecia M. Brown
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Office of Petitions